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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,630	01/02/2001	Syed F.A. Hossainy	M-8618 US	1934

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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/753,630	Applicant(s) HOSSAINY ET AL.	
	Examiner Jennifer K. Michener	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 40-48, 50-62, 78-81, 85-88, 100-101

Claim(s) withdrawn from consideration: 63

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Examiner did intend to state that claim 63 is non-elected, as outlined in the non-final action and reiterated in the final action. Claim 63 is grouped with the non-elected embodiment requiring the adhesion enhancer be placed in a second layer which has different effects than when placed in a first layer, as required by the previously examined claims. The specification states that the use of adhesion enhancers is to enhance adhesion to the base substrate. Inclusion of such a material in a second coating would have different functions and effects.

Specification

2. The objection to the specification is withdrawn based on removal of the new matter.

Claim Rejections - 35 USC § 112

3. Claims 100-101 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The rejection is maintained.

Applicant states that he is unclear as to which parts are new matter. Examiner directs Applicant to the discussion of the specification objection of the previous office action in which she outlines a non-limiting list of examples directed to the characterizations of the

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materials claimed. As one example only, the mere teaching of a vinyl pyridine group in the form of a specific "4-vinylpyridine benzyl chloride" chemical in an incorporated reference does not constitute basis for newly claiming all "ions containing vinyl pyridines". Examiner disagrees with Applicant that a patent teaching aryl species compounds is the "same as teaching an 'aromatic' genus". Examiner suggests cancellation of these claims to expedite prosecution and clarify the invention.

Claim Rejections - 35 USC § 102

4. Claims 60-62, 50-51, and 78-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Onishi et al. (5,670,558).

Examiner maintains the rejections.

5. Claims 60-62 and 78 are rejected under 35 U.S.C. 102(e) as being anticipated by Goicoechea (6,010,530).

Examiner maintains the rejection.

Claim Rejections - 35 USC § 103

6. Claims 58-59, 48, 100-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi in view of Rowland et al. (5,356,433).

Examiner maintains the rejection.

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7. Claims 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi in view of Rowland as applied to claims 58-59 and 48 above, and further in view of Hostettler (6,030,656).

Examiner maintains the rejection.

8. Claims 40-44, 52, 81, and 85-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi in view of Hostettler.

Examiner maintains the rejection.

9. Claims 45-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi in view of Hostettler as applied to claims 40-44, 81, and 85-88 above, and further in view of Shah (6,248,127).

Examiner maintains the rejection.

Response to Arguments

10. Applicant's arguments filed 6/04 have been fully considered but they are not persuasive.

Applicant argues that Examiner has cited no art to equate EVAL with an adhesion enhancer.

Examiner is not required to do so. EVAL is defined as such, as evidenced by Applicant's dependent claims. EVAL inherently meets the claim limitation.

Applicant's arguments regarding Goicoechea's incorporation of drug and polymer in the same application solution was thoroughly addressed in the previous office action.

Applicant argues that Goicoechea's polymer coating is not taught to act as an adhesion enhancer.

Examiner disagrees. The polymer coating will inherently provide better or "enhanced" adhesion over application of drug particles to a bare stent.

Applicant requests Examiner to provide structures of Rowland's compound of TDMAC to prove the reference meets the aromatic requirement of claim 4.

Examiner notes that she has not rejected claim 4 herein. Additionally, independent claim 101 does not require the "aromatic" limitation. Furthermore, in Examiner's rejections, she has stated that Rowland teaches the use of TDMAC or benzalkonium ions. Applicant states that Rowland does not "mention any benzyl groups let alone benzylalkonium chloride", however, Rowland does so at col. 2, line 18. It is upon this teaching that Examiner has relied to reject any claims requiring aromatic compounds.


Applicant argues that Rowland and Onishi are at cross purpose because Rowland desires to permanently bind heparin while Onishi requires leaching away of the drug. Examiner notes that she has relied upon Rowland's background section which teaches that drugs of this nature are known to leach away.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer K Michener whose telephone number is (571) 272-1424. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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July 1, 2004